

60,469-054
OT-4986REMARKS

Applicant thanks the Examiner for the remarks and analysis contained in the Office Action. Claims 1-9, 14-24 and 26-39 remain pending in this application. Applicant respectfully requests reconsideration of this application.

Applicant has amended claims 28, 32 and 36 to address the Examiner's concerns raised in paragraph 2 of the Office Action. Applicant respectfully submits that these claims satisfy 35 U.S.C. §112. Regarding the specification explaining the method of moving the cords while applying the belt, paragraphs 31-44, Figure 4, and paragraph 46 all provide information that those skilled in the art will understand includes moving cords in a longitudinal direction of the cords while applying the jacket of the belt. The directional arrows in Figure 4 and explicit statements regarding movement in paragraphs 41 and 46 are all examples of teachings from the specification regarding moving the cords.

Applicant respectfully traverses the rejections under 35 U.S.C. §103. There is no *prima facie* case of obviousness against any of Applicant's claims as described below.

In Applicant's previous response, Applicant discussed the *Kilborn, et al.* reference at length. Rather than repeating those comments here, Applicant respectfully requests the Examiner to reconsider the comments provided by Applicant in the most recent response.

The proposed combination of WO 01-14630 and *Kilborn, et al.* does not establish a *prima facie* case of obviousness against claims 1-4, 9, 15-16 and 24. The proposed combination cannot be made. There is no *prima facie* case of obviousness because there would be no benefit to making the proposed combination.

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The WO 01-14630 reference discloses an elevator belt assembly. Prior to Applicant's disclosed invention, that belt assembly would have been made using the prior art technique of supporting the cords at regular and relatively closely spaced intervals. Using a technique that would result in an arrangement as shown in Applicant's Figure 1 includes cord supports at the locations of the grooves in the jacket. With such arrangements, there would be no benefit to adding individualized cord tension because the cord geometry is already controlled by the supports. In other words, it appears that there would be no benefit to adding individual tension as taught by *Kilborn, et al.* to the state of the art technique for making the belt assembly disclosed in WO 01-14630 because the challenge faced when making a grooveless jacket as claimed (e.g., how to control cord position without the known supports) is not an issue when using known supports. The Examiner has not provided any indication (nor does either reference) regarding how *Kilborn's* technique will provide any benefit if added to the teachings of WO 01-14630.

If the Examiner's proposed combination is to substitute in the *Kilborn, et al.* manufacturing process for the belt-making process used for making elevator belts prior to Applicant's invention, there is no *prima facie* case of obviousness because it would not provide a workable result. There is nothing in the *Kilborn, et al.* reference to suggest that its technique can be used to make a belt as shown in WO 01-14630.

Kilborn, et al. teach an arrangement where sections of limited length of a fabric layer are applied to a conveyor belt. If such a sectional, limited-length approach were used for an elevator belt, that would cause even worse disruptions in the surface of the belt (e.g., seams) than the features of the belt that are disadvantageous as described in the

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background section of Applicant's specification and shown schematically in Applicant's Figure 1. In other words, the *Kilborn, et al.* technique is not useable for making elevator belt assemblies for the type of elevator equipment with which an elevator belt made according to an embodiment of Applicant's claimed invention would be useful.

Because there is no motivation for making the proposed combination of the WO 01-14630 and *Kilborn, et al.* references, there is no *prima facie* case of obviousness and none of claims 1-4, 9, 15-16 or 24 can be considered obvious.

Applicant respectfully traverses the rejection of claim 2 based upon the proposed combination of WO 01-14630 and *Kilborn, et al.* and *Bhagawat, et al.*. As just described, the base combination cannot be made. The proposed addition of the teachings of *Bhagawat, et al.* does not remedy the defect in the base combination. Moreover, *Bhagawat, et al.* does not "disclose a method of making a belt so that each of the cords has different tension in order to compensate for friction during application." The Examiner appears to be misquoting or misinterpreting the teachings of the *Bhagawat, et al.* reference. That document is teaching an arrangement that ensures "even tension" or "uniform tension" (column 3, lines 20-28; column 5, lines 29-31) on the filaments used in that arrangement.

Bhagawat, et al. teaches away from using different tensions because it describes that situation as a drawback or detriment to the tire manufacturing process described in *Bhagawat, et al.* Column 2, lines 44-56, make this clear where *Bhagawat, et al.* teach "The *problem* with this configuration, especially when applied to cords and strands used in the manufacture of tires, is that there can be a slightly different tension on each spool." (Emphasis added)

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The *Bhagawat, et al.* reference teaches away from or discourages one skilled in the art from using different tensions on cords or strands. It cannot, therefore, be used in a combination as proposed by the Examiner. There is no motivation for including a recognized problem from a reference into a proposed combination.

Applicant respectfully traverses the rejection of claims 5-7 as being unpatentable over the proposed combination of WO 01-14630, *Kilborn, et al.* and *Harper*. *Harper* does not disclose a polyurethane material free of wax as suggested by the Examiner. *Harper* discloses standard polyurethane materials, which typically include waxes. If the polyurethane material were waxless, *Harper* would have to expressly state that so that it would be recognized as an unusual polyurethane material.

Instead, *Harper* teaches an arrangement for avoiding oil or wax associated with a mold release agent from clinging to the exterior surface of a molded article. The use of wax-free surfaces in the title does not mean waxfree polyurethane. Column 1, line 51 and line 59; column 2, lines 12-13 and column 2, lines 42-43 are all examples of how *Harper* uses "wax-free" in the context of referring to the wax or oily substances used in a mold release agent. *Harper* does not teach a waxless polyurethane as contended by the Examiner.

Therefore, even if the combination could somehow be made, the result would not be the same as the claimed invention and there is no *prima facie* case of obviousness.

Further, there is no benefit to adding the teachings of *Harper* to the proposed combination of WO 01-14630 and *Kilborn, et al.* *Harper* describes an arrangement that is useful for making polyurethane articles that can be painted after they are molded. The elevator belt disclosed in the cited WO reference or the conveyor belt disclosed in

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Kilborn, et al. are not described in any way to suggest that they should or could be painted and, therefore, the purposes of the *Harper* reference do not have any beneficial use within either of the other two references. Without any benefit, there is no motivation for making the combination and no *prima facie* case of obviousness.

Applicant respectfully traverses the rejection in paragraph 8 of the Office Action of claims 19 and 24. Although only WO 01-14630 is mentioned in paragraph 8, the rejection of claim 19 must include the combination applied against claim 15, from which claim 19 depends. That combination cannot be made as already described above. The rejection of claim 24 in paragraph 8 appears to be a further explanation of the rejection of that claim in paragraph 5 of the Office Action. Applicant has already addressed why that proposed combination does not establish a *prima facie* case of obviousness.

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. §103 based upon the proposed combination of WO 01-14630, *Kilborn, et al.* and *Tsai*. There is no *prima facie* case of obviousness because there would be no benefit to adding the teachings of *Tsai* to the proposed combination of the other two references (even if the base combination could be made, which Applicant has already explained cannot be). The molding device in *Tsai* is intended to form an outer covering on an electrical conductor. There would be no benefit to adding such a mold to the arrangement of WO 01-14630 or *Kilborn, et al.*, both of which disclose a flat exterior on a belt.

If one were to substitute the molding technique of *Tsai*, the flat exterior of the belt would be lost and a sheath like that shown in *Tsai* would be the intended result. There is nothing in *Tsai* that suggests any other configuration as the end result. There would be no benefit to changing the configuration of the *Kilborn, et al.* conveyor belt or the

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elevator belt of the WO 01-14630 reference to have a jacket shaped like the exterior of *Tsai's* conductor. Therefore, there is no motivation for making the proposed combination.

Additionally, the *Tsai* reference relates to electrical conductors which are not analogous art to elevator belts or conveyor belts. This is another reason why the proposed combination cannot be made and there is no *prima facie* case of obviousness.

Applicant respectfully traverses the rejection of claim 14 based upon the proposed combination of WO 01-14630 and *Harper*. As described above, *Harper* does not disclose a polyurethane material free of wax. Instead, *Harper* discloses an arrangement that attempts to avoid the deposit of a wax or oil associated with a mold release agent onto the surface of a molded article that comprises polyurethane. Therefore, the combination, even if it could be made, does not provide the same result as the claimed invention.

Additionally, the combination cannot be made because there is no motivation for making it. There would be no benefit to adding the techniques of *Harper* to the teachings of the WO 01-14630 reference because *Harper* teaches an arrangement that facilitates painting the exterior of a molded article. There is nothing in the cited references that suggests any use for painting the exterior of a belt as described in the WO 01-14630 reference or *Kilborn's* conveyor belt and, therefore, no benefit to making the combination. Where a proposed combination provides no benefit, the legal motivation required for making the combination is missing and there is no *prima facie* case of obviousness.

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Applicant respectfully traverses the rejection of claims 20 and 26-27 based upon the proposed combination of WO 01-14630 and *Harper*. As already described, this combination cannot be made and does not provide the same result as the claimed invention.

Applicant respectfully traverses the rejection of claims 35 and 39 stated in paragraph 12 of the Office Action, which is based upon the combination of WO 01-14630, *Harper* and *Pitts, et al.* There is no *prima facie* case of obviousness. There is no motivation for combining those three references.

Additionally, claim 35 depends from claim 5 so that any attempt to establish a *prima facie* case of obviousness would have to include the proposed addition of *Kilborn, et al.* That combination cannot be made any more than the combination of the three references mentioned in paragraph 12 of the Office Action.


Claim 39 depends from claim 24. Therefore, any attempted rejection under 35 U.S.C. §103 would have to include the proposed combination applied against claim 24 from paragraph 5 of the Office Action. As described above, that combination does not establish a *prima facie* case of obviousness. The proposed addition of *Harper* and *Pitts, et al.* do not establish a *prima facie* case of obviousness, either.

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There is no *prima facie* case of obviousness against any of Applicant's pending claims. This application is in condition for allowance.

Respectfully submitted,

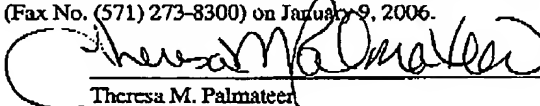
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CERTIFICATE OF FACSIMILE

I hereby certify that this Response relative to Application Serial No. 10/010,937 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on January 9, 2006.


Theresa M. Palmateer

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